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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,703	04/02/2004	Rainer Kropke	P25110	9720

7055 7590 06/28/2006

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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/815,703	Applicant(s) KROPKE ET AL.	
	Examiner Marina Lamm	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-42 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 10-42 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/15/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 10-42 are pending in this application filed 4/2/04, which is a continuation of PCT/EP02/10919 filed 9/28/02, which claims foreign priority to the German application No. 101 48 966.8 filed 10/4/01.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10-20, 25, 27-36 and 38-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Jutila (WO 98/13021).

Jutila teaches cosmetic preparations in the form of creams, lotions, O/W and W/O emulsions for skin care and cleansing, said preparations containing 0.1-20% of trimethylglycine. See p. 4, lines 9-29. The composition of Jutila may contain anti-oxidation agents. See p. 4, line 17. Jutila exemplifies a lotion composition containing 4% by weight of trimethylglycine and 5.5% by weight of glycerine. See p. 9, Example 2, lines 15-26; also see "Foot cream 3" on p. 10 and "Astringent after-shave gel" on p. 11. With respect to Claims 38-42, the Jutila reference teaches the claimed method step, i.e. "incorporating into the composition one or more betaines." Therefore, the claimed results will be inherent in the prior art reference. "It is a general rule that merely discovering and claiming a new benefit of an old process cannot render the process

again patentable.” *In re Woodruff*, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). The mechanism of action does not have a bearing on the patentability of the invention if the invention was already known or obvious. Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 201 USPQ 658 (CCPA 1979). Granting a patent on the discovery of an unknown but inherent function would remove from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art. *In re Baxter Travenol Labs*, 21 USPQ2d 1281 (Fed. Cir. 1991). See M.P.E.P. 2145.

Thus, Jutila teaches each and every limitation of Claims 10-20, 25, 27-36 and 38-42.

3. Claims 10-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito et al. (US 6,008,246).

Ito et al. teach external preparations for the skin comprising 0.1-30% of a betaine such as trimethylglycine. See Abstract; col. 2, lines 15-18. The compositions of Ito et al. contain moisturizing ingredients such as glycols, sorbitol or glycerine; antioxidants such as vitamins A and/or E and/or C, BHT, BHA; UV absorbers; powder ingredients such titanium dioxide and other conventional cosmetic ingredients. See col. 9, lines 11-17; col. 10, lines 38-47; col. 12, lines 3-5, 28-49. The compositions of Ito et al. may be in the form of emulsions, creams, lotions, foams, etc. See col. 10, lines 7-26; Examples. Ito et al. exemplify a skin lotion containing 0.1% by weight of Vitamin E acetate (antioxidant), 8% by weight of sorbitol (polyol), 5% by weight of 1,3 butylene

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glycol (polyol) and 2% by weight of trimethylglycine (betaine). See col. 24, lines 25-40. Further, the reference exemplifies a composition containing 10% by weight of trimethylglycine (betaine), 5% by weight of dipropylene glycol (polyol), 0.15% by weight of polyethylene glycol (polyol), 2-ethylhexyl 4-methoxycinnamate (UV absorber), dl-tocopheryl acetate (antioxidant), and other cosmetic ingredients. See col. 27, lines 36-59. With respect to Claims 38-42, the Ito et al. reference teaches the claimed method step, i.e. "incorporating into the composition one or more betaines." Therefore, the claimed results will be inherent in the prior art reference. See above.

Thus, Ito et al. teach each and every limitation of Claims 10-42.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jutila (WO 98/13021).

Jutila applied as above. While teaching antioxidants as discussed above, the reference does not explicitly teach the claimed concentration of anti-oxidation agents. However, the determination of optimal or workable concentration of anti-oxidation agents by routine experimentation is obvious absent showing of criticality of the claimed

concentration. One having ordinary skill in the art would have been motivated to do this to obtain the desired anti-oxidant properties and/or stability of the composition.

6. Claims 21-24 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jutila (WO 98/13021) in view of Ito et al. (US 6,008,246).

Jutila applied as above. The reference does not explicitly teach UV filters of Claims 21 and 22; pigments of Claims 23 and 24 and a sunscreen of Claim 37.

However, Ito et al. teach external preparations for the skin comprising 0.1-30% of a betaine such as trimethylglycine in combination with polyols, UV filters and/or pigments as discussed above. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the cosmetic compositions of Jutila such that to employ UV filters and/or pigments of Ito et al. for their art-recognized purpose. One having ordinary skill in the art would have been motivated to do this to obtain improved skin protection against solar radiation.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,952,275 (see Claim 1); US 2002/0041889 (see [0070], [0088], [0094]); WO 92/19275 (see pp. 6, 8).

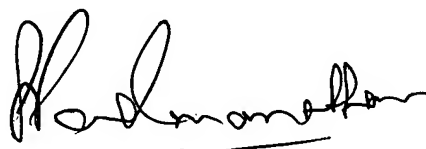
8. No claims are allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 7pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, can be reached at (571) 272-0629.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm, M.S., J.D.
Patent Examiner
6/12/06


SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER